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10/629,792	07/30/2003	Takeshi Kato	011350-314	9403
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EXAMINER				
LIN, SHEW FEN				
ART UNIT		PAPER NUMBER		
2166				
NOTIFICATION DATE		DELIVERY MODE		
12/22/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/629,792

Applicant(s)

KATO, TAKESHI

Examiner

SHEW-FEN LIN

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 8, 13 and 14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 5, 8, 13-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

- a. This action is taken in response to Request for Continued Examination filed on 9/23/2008.
- b. Claims 5, 8, and 13-14 are pending in this Office Action. Claims 5, 8, and 13 are independent claims.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 23, 2008 has been entered.

Response to Amendments

In view of the amendment to claim 14, the Examiner withdraws the claim objection stated in the previous office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5, and 13-14 are rejected under 35 U.S.C. 102(c) as being anticipated by Smith (US Patent 6,931,661).

As to claim 5, Smith discloses **a file storage device** (abstract, col. 4, lines 24-26, remote server stores images) **that communicates with a portable terminal** (abstract, transmitted image on a display of the portable device), **comprising:**

a thumbnail image transmitting part for transmitting a thumbnail image for a specified file to said portable terminal in response to a request from said portable terminal (Fig. 5, col. 2, lines 38-44, col. 3, lines 51-61, col. 4, lines 24-26, col. 7, lines 1-3, transmitting a plurality of graphic images in thumbnail format, from the remote server to the wireless portable device);

an enlarged image generating part that is responsive to a request from said portable terminal containing a coordinate of an enlargement reference point of said thumbnail image and an enlarging ratio relative to said thumbnail image (col. 2, lines 3-7, lines 45-58, col. 3, lines 4-11, the touch screen capability is utilized to indicate the center location of the next segment to display [i.e. reference point], and the zoom is increased by a factor of 2. Other zoom rates [i.e. enlarging ration] could be set through user preferences, col. 4, lines 51-54, request to expand image) , **for generating an enlarged image of said thumbnail image, said enlarged image corresponding to said a coordinate of an enlargement reference point of said**

thumbnail image and enlarging ratio relative to said thumbnail image (abstract, The user selects a portion of the image to be further expanded and the master database is again processed to form a second subset of data representative of the selected portion of the image, Figs. 3, 5, col. 2, lines 45-58, col. 4, lines 55-59, remote server expand selected portion of image); and

an enlarged image transmitting part that receives the enlarged image from the enlarged image generating part and transmits the enlarged image generated to said portable terminal (Fig. 5, col. 2, lines 45-58, filtering and transmitting is repeated for a zooming sequence [i.e. transmit expanded image for each zoom]. The total number of bytes transmitted for each zoom can be fairly low relative to the original image, while the potential to dig in to get additional detail is maintained, col. 4, lines 60-64, transmit the expanded image).

As to claim 13, has the same subject matter as of claim 5 and as such rejected under the same rationale.

As to claim 14, is directed to a computer readable medium carrying instructions to perform the same subject matter as of claim 5 and as such rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US Patent 6,931,661) in view of Parulski et al. (US Patent Publication 2003/0193603, hereinafter referred as Parulski).

As to claim 8, Smith discloses a printing system, comprising:

a file storage device for storing a file (abstract, col. 4, liens 24-26, remote server stores images);

a printing device communicable with said file storage device; and

a portable terminal communicable with said file storage device (abstract, transmitted image on a display of the portable device), **wherein**

a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal;

said file storage device including:

a thumbnail image transmitting part for transmitting a thumbnail image for a specified file to said portable terminal in response to a request from said portable terminal (Fig. 5, col. 2, lines 38-44, col. 3, lines 51-61, col. 4, lines 24-26, col. 7, lines 1-3, transmitting a plurality of graphic images in thumbnail format, from the remote server to the wireless portable device);

an enlarged image generating part that is responsive to a request from said portable terminal containing a coordinate of an enlargement reference point of. said thumbnail image and an enlarging ratio relative to said thumbnail image (col. 2, lines 3-7, lines 45-58, col. 3, lines 4-11, the touch screen capability is utilized to indicate the center location of the next segment to display [i.e. reference point], and the zoom is increased by a factor of 2. Other zoom rates [i.e. enlarging ration] could be set through user preferences, col. 4, lines 51-54, request to expand image), **for generating an enlarged image of said thumbnail image, said enlarged image corresponding to said a coordinate of an enlargement reference point of. said thumbnail image and enlarging ratio relative to said thumbnail image** (abstract, The user selects a portion of the image to be further expanded and the master database is again processed to form a second subset of data representative of the selected portion of the image, Figs. 3, 5, col. 2, lines 45-58, col. 4, lines 55-59, remote server expand selected portion of image); and

an enlarged image transmitting part that receives the enlarged image from the enlarged mage generating part and transmits the enlarged image generated to said portable terminal (Fig. 5, col. 2, lines 45-58, filtering and transmitting is repeated for a zooming sequence [i.e. transmit expanded image for each zoom]. The total number of bytes

transmitted for each zoom can be fairly low relative to the original image, while the potential to dig in to get additional detail is maintained, col. 4, lines 60-64, transmit the expanded image);

said portable terminal including:

a display part for displaying the thumbnail image (Fig. 5, thumbnails) and the enlarged image received from said file storage device (Figs. 1-3, display expanded images).

Smith does not explicitly disclose a printing system comprising a printing device communicable with said file storage device; and a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal.

However, it is a well-known and common practice in the art to connect printer device to a computer to print file/images required by the user.

Further, Parulski discloses a printing system (Fig. 6) comprising: a printing device communicable with said file storage device (Fig. 6, 270, 290); and wherein a file stored in said file storage device is printed by said printing device based on an instruction from said portable terminal (Fig. 428, Fig. 9, 516, paragraph 0022, 0050, 0063, Photo phone 12 also enables a user to order prints and other photo/image related products using these digital images).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Smith's disclosure to include printer in the image viewing system as taught by Parulski for the purpose of enables a user to order prints and other photo/image related products using a cellular telephone (paragraph 0022). The skilled artisan would have been motivated to improve the invention of Smith per the above to print the images through portable phone.

Response to Arguments

Applicant's arguments with respect to claims 5, 8, and 13-14 have been fully and carefully considered but are moot in view of the new ground(s) of rejection.

Related Prior Arts

The following list of prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Rodriguez; John et al., US 7154621 B2, "Internet delivery of digitized photographs".
- Iida; Takayuki, US 7092010 B2, "Image photographing system".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shew-Fen Lin /S. L./
Examiner, Art Unit 2166
November 21, 2008

/Hosain T Alam/
Supervisory Patent Examiner, Art Unit 2166